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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,879	12/16/1999	JOHN L. BEEZER	3797.84611	9430

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EXAMINER

TRAN, MYLINH T

ART UNIT	PAPER NUMBER
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2174

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DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/465,879

Applicant(s)

JOHN L. BEEZER

Examiner

Mylinh T Tran

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment filed 03/26/03.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9 and 11-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9 and 11-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Applicant's Amendment filed 03/26/03 has been entered and carefully considered. Claims 1 and 9 have been amended. However, limitations of amended claims have not been found to be patentable over prior art of record and newly discovered prior art, therefore claims 1, 3-9, 11-28 are rejected under the new ground of rejection as set forth below.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-9, 11-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs et al. [US. 5,956,034] in view of Brown et al. [US. 2003/0079179].

As to claims 1 and 9, Sachs et al. discloses displaying at least a portion of the electronic document to the user as an immersive reading page, the immersive reading page mimicing a printed paper (figure 3A, (100), column 2, lines 50-60 and column 5, lines 41-52); associating with an element of the immersive reading page enhanced page functionality (column 5, lines 52-65, column 6, lines 1-13 and column 6, lines 41-52). Sachs et al. cites "Navigation of the reading materials is effected by different functions as represented by a plurality

of function display" read as the enhanced page functionality. Each icon in figure 3B; (120-138) represents one enhanced functionality; providing the user access to the enhanced functionality in response to the user selecting the element of the immersive reading page (column 5, lines 57-60, Sachs cites "Similarly, an icon representing the function of turning to the previous page enables the user to go back through the text"). The difference between Sachs et al. and the claim is "no visual indication of the enhanced functionality is provided prior to the user selecting the element of the immersive reading page". While Sachs shows the immersive reading page, Brown et al. teach "no visual indication" at figure 10, column 3, [0045] and column 4, 90049]. Both references show the elements of the enhanced functionality. However, while Sachs shows the enhanced functionality with visual indication, Brown provides the enhanced functionality without visual indication. It would have been obvious to one of ordinary skill in the art, having the teachings of Sachs et al. and Brown before them at the time the invention was made to modify the immersive reading page as taught by Sachs et al. to include the enhanced functionality with no visual indication of Brown, with the motivation being to save space of a screen and provide menu only when user wants to see as taught by Brown.

As to claims 3 and 11, Sachs et al. also discloses the enhanced functionality is transparently associated with the element of the immersive reading page (figure 4A, (142), column 4, lines 50-55).

Art Unit: 2174

As to claims 4 and 12, Sachs et al. teaches the step of invoking a training mode for teaching the association to a user (figure 2B, (86a), column 4, lines 35-55).

As to claims 5 and 13, Sachs et al. also teaches the element that is a page number and the step of associating comprises associating intrabook navigational functionality with the page number (column 5, lines 51-55 and column 8, lines 60-68).

As to claims 6 and 14, Sachs et al. shows the element is a title line and the step of associating comprises associating interbook navigational functionality with the title line (column 7, lines 37-44).

As to claims 7 and 15, Sachs et al. also shows the element is content and the step of associating comprises associating content interaction functionality with the content (column 7, lines 44-55).

As to claims 8 and 16, Sachs et al. demonstrates the step of associating comprises the step of associating a first category of enhanced functionality with a first category of element on the immersive reading page (column 5, lines 44-55).

As to claims 17 and 23, Sachs et al. also demonstrate the enhanced functionality includes highlighting (column 7, lines 1-18).

As to claims 19 and 28, Sachs et al. suggests the enhanced functionality includes drawing (column 2, lines 50-55).

Art Unit: 2174

As to claims 20 and 25, Sachs et al. also suggest the enhanced functionality includes adding a bookmark indicator in relation to the immersive reading page (column 5, line 65 through column 6, line 5).

As to claims 22 and 27, Sachs et al. discloses the electronic document is a book in electronic form and the immersive reading page mimics a printed paper page of a book (column 1, lines 47-58 and column 2, lines 62-68).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 21, 24 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs et al. [US. 5,956,034] in view Brown et al. [US. 2003/0079179] and further in view of Sachs et al. [US. 6,493,734].

As to claims 18, 21, 24 and 26, the difference between Sachs [US. 5,956,034], Brown et al. [US. 2003/0079179] and the claim is the enhanced functionality includes annotating and a note to the immersive reading page. Sachs et al. [US. 6,493,734] shows the feature at column 3, lines 50-58. It would have been obvious to one of ordinary skill in the art, having the teachings of Sachs [US. 5,956,034], Brown et al. [US. 2003/0079179] and Sachs [US. 6,493,734] before them at the time the invention was made to modify the

enhanced functionality taught by Sachs et al. [US. 5,956,034] and Brown et al. [US. 2003/0079179] to include specific features functionality of Sachs [US. 6,493,734], with the motivation being to be able to provide additional advantageous features to the users as taught by Sachs [US. 6,493,734].

***Response to Arguments***

Applicant's argument with respect to claims 1, 3-9 and 11-28 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Conclusion***

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires fax a response, (703) 746-7238, may be used for formal After Final communications, (703) 746-7239 for Official communications, or (703) 746-4395 for Non-Official or draft communications. NOTE, A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for information facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran whose telephone number is (703) 308-1304. The examiner can normally be reached on Monday-Thursday from 8.00AM to 6.30 PM

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640,

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the



Art Unit: 2174

confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Mylinh Tran

Art Unit 2174

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